

REMARKS

Claims 55-76 are now pending in the application. Claim 55 has been amended. Claim 55 has been amended to include the limitations of former claims 9, 14 and 49. Claims 56-76 are similar to former claims 2-4, 6-13, 16-17, 19-25 and 48. Therefore, no search is necessary and the amendment should be entered.

Claim Rejections – 35 U.S.C. § 112

The Patent Office rejected claims 50, 51 and 52 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant respectfully traverses; however, claims 50-52 have been canceled without prejudice, thus the rejection is now moot.

Claim Rejections – 35 U.S.C. § 103

The Patent Office rejected claims 1-4, 7-10, 16-19, 21, 26-30, 48, 50 and 55 under 35 U.S.C. § 103(a) as being unpatentable over Bashan et al., U. S. Patent No. 6,202,927, ("Bashan") in view of Doyle et al., U.S. Publication No. 20020095587, ("Doyle") in further view of O'Gorman et al., U.S. Patent No. 6,970,584, ("O'Gorman").

The Patent Office rejected claims 5, 6, 11-13 under 35 U.S.C. § 103(a) as being unpatentable over Bashan et al., U. S. Patent No. 6,202,927, ("Bashan") in view of Doyle et al., U.S. Publication No. 20020095587, ("Doyle") in view of O'Gorman et al., U.S. Patent No. 6,970,584, ("O'Gorman") in further view of Elteto et al., U.S. Patent No. 7,111,324, ("Elteto")

The Patent Office rejected claims 14, 20 and 22-25 under 35 U.S.C. § 103(a) as being unpatentable over Bashan et al., U. S. Patent No. 6,202,927, ("Bashan") in view of Doyle et al., U.S. Publication No. 20020095587, ("Doyle") in view of O'Gorman et al.,

U.S. Patent No. 6,970,584, ("O'Gorman") in further view of Jachimowicz et al., U.S. Patent No. 5,734,154, ("Jachimowicz").

The Patent Office rejected claims 42-47 under 35 U.S.C. § 103(a) as being unpatentable over Doyle et al., U.S. Publication No. 20020095587, ("Doyle") in view of Elteto et al., U.S. Patent No. 7,111,324, ("Elteto") in further view of O'Gorman et al., U.S. Patent No. 6,970,584, ("O'Gorman").

The Patent Office rejected claims 49, 51 and 52 under 35 U.S.C. § 103(a) as being unpatentable over Bashan et al., U. S. Patent No. 6,202,927, ("Bashan") in view of Doyle et al., U.S. Publication No. 20020095587, ("Doyle") in view of O'Gorman et al., U.S. Patent No. 6,970,584, ("O'Gorman") in further view of Mosher Jr., et al., U.S. Publication 20030173408, ("Mosher").

The Patent Office rejected claims 53 and 54 under 35 U.S.C. § 103(a) as being unpatentable over Doyle et al., U.S. Publication No. 20020095587, ("Doyle") in further view of Elteto et al., U.S. Patent No. 7,111,324, ("Elteto") in view of O'Gorman et al., U.S. Patent No. 6,970,584, ("O'Gorman") in further view of Mosher Jr., et al., U.S. Publication 20030173408, ("Mosher").

Applicant respectfully traverses each rejection under 35 U.S.C. § 103(a). The present application is directed to a transaction authentication card including a biometric sensor which may be utilized to gain access to a restricted area when a biometric feature matches stored biometric data. In an advantageous aspect of the present invention, the transaction authentication card of the present invention may enroll a user without any additional equipment. Thus, biometric information, which is very precious to many users, is not deposited within a database and may never be retrieved.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). See also *In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970).

Additionally, obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). Thus, the Examiner may not use the patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention.

Regarding claim 55, Applicant respectfully submits claim 55 recites elements which have not been disclosed, taught or suggested by Bashan, Doyle, Elteto, Jachimowicz, O'Gorman and Moster, individually or in combination. For example, claim 55 recites the transaction authentication card including "said processor is configured for enrollment of said biometric feature of said user and storage of said biometric data representing said biometric feature of said user acquired during enrollment within said first memory."

The Patent Office correctly states that Bashan and Doyle "does not disclose whereby said processor is configured for enrollment of a biometric feature of said user." (Office Action of August 20, 2007, Page 15). However, O'Gorman fails to cure the defects of Bashan and Doyle. The Patent Office cites Column 1, Lines 39-43, Column 2, Lines 34-44 and Column 5, Lines 46-48 for support of its assertion. However, these passages merely disclose enrollment of a biometric feature and fail to disclose, teach or suggest "said processor is configured for enrollment of said biometric feature of said user and storage of said biometric data representing said biometric feature of said user acquired during enrollment within said first memory."

O'Gorman fails to disclose a processor configured for enrollment of said biometric feature. In fact, the text of O'Gorman fails to recite a processor. Rather, O'Gorman merely discloses an enclosure 100 for a fingerprint sensor device 130 which is not equivalent to "said processor is configured for enrollment of said biometric feature of said user and storage of said biometric data representing said biometric feature of said

user acquired during enrollment within said first memory." Under *In re Ryoka*, a *prima facie* case of obviousness has not been established for claim 55. Claims 56-76 should be allowed due to their dependence upon an allowable base claim.

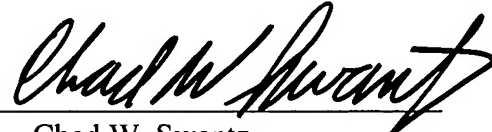
CONCLUSION

In light of the forgoing, entry of the amendment and allowance of the claims is earnestly solicited.

Respectfully submitted,

Resilent, LLC

Dated: October 30, 2007

By: 
Chad W. Swantz
Reg. No. 46,329

Chad W. Swantz
SUITER • SWANTZ PC LLO
14301 FNB Parkway, Suite 220
Omaha, NE 68154
(402) 496-0300 telephone
(402) 496-0333 facsimile